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- Claim 31 as being unpatentable over Isaacson in view of Danknick and further in view of Noble et al. (Noble)[1];
- Claims 42 and 44 as being unpatentable over Isaacson in view of Danknick, further in view of Poole and further in view of Noble[2];
- Claim 59 as being unpatentable over Isaacson in view of Danknick, further in view of Poole and further in view of Dunphy et al. (Dunphy); and
- Claims 91-95, 107, 112 and 113 as being unpatentable over Danknick in view of Poole.

Applicants respectfully traverse the Examiner's rejections.

As explained in Applicant's previous Amendment, filed October 5, 2001, none of the

prior art references discloses, teaches or suggest systems, methods and software, for production

of documentation for configurable computerized systems, having unique combinations of

features which include:

> organizing said explanatory information ["corresponding with at least one of said configuration parameters and a value associated with said parameter"] ... into a narrative format descriptive of the configuration of the configurable system, the narrative format constituting the documentation, or a portion of the documentation, for said configurable system (Applicants' independent claim 1; see also claims 36, 49, 78, 94 and 95)

or

> outputting explanatory information corresponding with at least one of said configuration parameters and a value associated with said parameter in a narrative format descriptive of the configuration of the configurable system, to form the documentation or a portion

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[1] Applicants respectfully submit that this rejection (as set forth in paragraph 10 of the Office Action) is inconsistent with the Examiner's withdrawal of the rejection of claim 31 as being unpatentable over Isaacson in view of Danknick and further in view of Noble (see Office Action, paragraph 4). As noted by Applicant's representative in a telephonic interview with the Examiner (conducted on April 22, 2002), the Examiner is respectfully requested to clarify, or withdraw this rejection.

[2] As further noted during the April 22, 2002 interview between the Examiner and Applicants' representative, the Examiner is respectfully requested to provide an explanation as to the motivation for combining Poole with the third reference, Noble, cited in this rejection.

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> thereof (Applicants' independent claim 8; see also claims 18, 39,
> 43, 55, 59, 67, 80, 86 and 91)

The Examiner acknowledges that the combinations of previously cited Isaacson, Danknick, Noble and Dunphy references do not disclose or suggest Applicants' claimed invention (Office Action, paragraphs 3-6), and relies in Poole to supply the acknowledged deficiencies of the previously cited references.

Poole discloses an apparatus and method for dynamically constructing electronic and printable documents and forms from other documents. (See *Id.*, Abstract). In this regard, Poole utilizes Standard Generalized Markup Language (SGML) to construct documents formatted in accordance with a specific presentation style from other previously-created documents. (see Id., col. 5, line 25 through col. 7, line 27). Nowhere does Poole, or any of the cited prior art references, teach or suggest how Poole's disclosure may be applied to "a method and apparatus for automatically configuring a number of communication programs that are resident on a number of computer platforms," wherein "[t]he configuration program solicits user configuration information from a user through a user interface" (Isaacson, col. 2, lines 17-27), or to a method and apparatus for communicating with a network peripheral (such as a copier) wherein current configuration settings of the peripheral are transferred and displayed in the form of an "Administration" HTML page downloaded from an HTTP server. (See Danknick, col. 7, lines 1-20, and Figs. 9 and 10).

Indeed, Poole has nothing to do with extracting, identifying or describing system or peripheral configuration parameters. Instead, Poole utilizes SGMS, which is "a language for document representation that formalizes markup and frees it of system and processing

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<u>dependencies</u>" (Id, col. 3, lines 50-52, emphasis added), to "integrate components selected from the stream 40 of components [of other documents] into SGML documents of varying types and styles" (see Id., col. 5, lines 25-28). Neither Poole, nor Danknick, give any hints as to how, or why a skilled artisan would implement Poole's method/apparatus for dynamically creating documents from components of other documents in Danknick's method/apparatus for communicating with a network peripheral via a user interface where configuration parameters of a peripheral are displayed together with icons "which, when selected, cause administrative functions to be executed within the [peripheral]" (see Danknick, col. 7, lines 12-20 and col. 7, line 66 through col. 9, line 26). Likewise, Neither Poole, nor Isaacson, give any hints as to how or why a skilled artisan would implement Poole's method/apparatus for dynamically creating documents from components of other documents in Isaacson's method/apparatus for configuring programs resident on configurable computerized systems (i.e., on the "computer platforms").

Thus, the Examiner's combination of Isaacson and/or Danknick with Poole is improper. *In re Lee*, 61 USPQ2d 1431 (January 18, 2002) (holding that "a specific hint or suggestion" of motivation in a particular reference to combine prior art references is required); *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) ("[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the hole claimed invention"); *In re Dance*, 160 F. 3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) ("[T]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant").

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Finally, the Examiner alleges that "Poole teaches the dynamic creation of documents ...

including a narrative explanation of corresponding parameters or values associated with the

documentation" (see Office Action, pages 4-5).  However, this proposition does not bolster the

Examiner's position, because one of the essential features of Applicants' claimed invention is to

output "explanatory information corresponding with at least one of said configuration parameters

[i.e., parameters describing the state of a configurable system] and a value associated with said

parameter in a narrative format" (see Applicant's independent claims 1, 8, 18, 36, 39, 43, 49, 55,

59, 67, 78, 80, 86, 91, 94 and 95).

Since Noble and Dunphy likewise do not disclose, teach or suggest the above noted

features of Applicants' invention, and like Isaacson and Danknick do not provide any hints as to

how or why a skilled artisan would implement Poole's disclosure in any of the cited prior art

references, Applicants' independent claims 1, 8, 18, 36, 39, 43, 49, 55, 59, 67, 78, 80, 86, 91, 94

and 95, as well as the dependent claims 2-7, 9-17, 19-38, 40-42, 44-48, 50-53, 56-58, 60-66, 68-

77, 79, 81-85, 87-90, 92, 93 and 96-113 (which incorporate all the novel and unobvious features

of their respective base claims), would not have been obvious from any reasonable combination

of the cited prior art references.

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited.  If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly requested to contact the undersigned attorney at the telephone number listed below.

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Applicant submits herewith a Petition for Extension of Time of one month and hereby

petitions for any additional extension of time which may be required to maintain the pendency of

this case, and any additional required fee, except for the Issue Fee, for such extension is to be

charged to Deposit Account No. 19-4880.

                                                    Respectfully submitted,
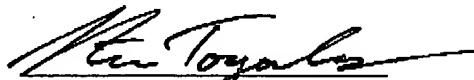
SUGHRUE, MION, ZINN,                                Stan Torgovitsky
  MACPEAK & SEAS, PLLC                              Registration No. 43,958
2100 Pennsylvania Avenue, N.W.
Washington, D.C.  20037-3213
Telephone:  (202) 293-7060
Facsimile:  (202) 293-7860

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